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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,381	09/23/2003	David E. Bostdorf	11393.00	6065

29994 7590 08/25/2005
DOUGLAS S. FOOTE
NCR CORPORATION
1700 S. PATTERSON BLVD. WHQ5E
WHO-5E
DAYTON, OH 45479

EXAMINER

WATKINS III, WILLIAM P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,381

Applicant(s)

BOSTDORF, DAVID E.

Examiner

William P. Watkins III

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election with traverse of Group I, claims 1-12 and 20, in the reply filed on 07 June 2005 is acknowledged. The traversal is on the ground(s) that the process is not distinct from the product and therefore the three-way restriction is not proper. This is not found persuasive because the method is distinct since the product could be made by another method such as cutting in sheet form as indicated in the restriction requirement or by cutting with a laser. Applicant argues that since method claim 13 is dependent on claim 3 it therefore includes all of the limitations of claim 3 and cannot be distinct from that claim. The examiner disagrees. The test is not if the method claim includes all of the limitations of the article, as it must if it makes the claimed article. The test of being distinct is based on there being another way to make the article, which has been given as noted above.

Applicant also argues that there is no burden on the office. The different classifications provide burden. The examiner notes that Groups II and III, were improperly classified in the restriction requirement mailed 19 May 2005 and should be classified in class 271/8.1 and 83/29 respectively. A

full search of the method classifications was not required to establish the patentability of the article claims.

Regarding distinctness Group II and Group I, the article could be used in a different process such as holding credit cards. The article does not have to be fed to a printer or printed in order to be used to hold a card. Regarding distinctness of Groups II and III, the groups are subcombinations of an unclaimed generic method of forming the die cuts, stacking, and then feeding to a printer. The article in claim 3 has nothing to do with the method step combination. The method claims will be considered for rejoinder at the time of allowance, if they are dependent or otherwise include all of the limitations of any allowed article claims (see MPEP 821.04).

The requirement is still deemed proper and is therefore made FINAL.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Spencer (U.S. 3,900,629).

The reference shows a stack of sheet layers with openings cut in the sheet layers, with the openings being offset between alternate layers of the stack (abstract, Figure 1). Regarding claims 9-11, Figure 4 shows edges of cuts that are straight in pairs that are adjacent a curved edge of the cut. The examiner does not give specific weight to the openings being die cut as it is not clear how hole formation by this means differs from hole formation by another means such as laser cutting. This said, the examiner notes that the reference at col. 3, lines 60-65, teaches using stamping to form the openings, which the examiner takes as a form of cutting with a die.

4. Claims 1-9, 11-12 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by May (U.S. 5,447,299).

See Figure 3, which shows offset holes in different layers, which prevent jamming, as well as straight die cuts adjacent circular holes, and side folds on each side of the central area. No specific weight is given to the method of hole formation a noted above.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions of a commercial product that holds key cards (paragraphs 005 and 009) and has die cuts and May (U.S. 5,447,299).

Applicant admits that a keycard holder configuration of silts in a folded sheet is in commercial use. May teaches offsets in openings in stacked sheets to allow entry of air and prevent jamming when printing various sheet products such as cards (col. 4, lines 45-65, col. 6, lines 45-55). The instant invention claims curved and straight cut areas in a sheet with a central portion and two side portions. It would have been obvious to one of skill in the art to have offset the openings in the stacks of the admitted cardholder of applicant in order to prevent jamming when feeding the sheets into various processing machines.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww

August 21, 2005